

REMARKS

In the Office Action¹, the Examiner rejected claims 1, 4, 5, and 9 under 35 U.S.C. § 112 as indefinite, and rejected claims 1-9 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,012,088 to Li et al. ("*Li*") in view of U.S. Patent No. 6,130,892 to Short et al. ("*Short*").

By this Amendment, Applicants amend claims 1-9 and add new dependent claims 10-17. Claims 1-17 are pending and under examination.

Applicants respectfully traverse the rejection of claims 1, 4, 5, and 9 under 35 U.S.C. § 112. The Examiner states: "Claim 1, 4-5, 9 recites the limitation 'a storage medium.' This limitation is vague and indefinite. Is the install medium installed on the client or the server or the ISP? It is not clear because the storage medium is associated with the ISP, Internet server, and client but is locally installed somewhere." Amended claim 1 now recites:

storing, by the Internet service provider, the connection setup information on a storage medium; and
transferring the storage medium from the Internet service provider to the client;
wherein the connection setup information allows the client to have the Internet server set up for Internet access by locally installing the storage medium in the server ...

Amended claims 4, 5, and 9 similarly specify the way in which the claimed method uses the storage medium. Applicants submit the amended claims are no longer vague or indefinite and request the Examiner to withdraw the rejection.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Applicants respectfully traverse the rejection of claims 1-9 under 35 U.S.C.

§ 103(a). Independent claim 1, for example, recites a method of setting up an Internet server, comprising the steps of:

storing, by the Internet service provider, the connection setup information on a storage medium; and
transferring the storage medium from the Internet service provider to the client;
wherein the connection setup information allows the client to have the Internet server set up for Internet access by locally installing the storage medium in the server

None of the cited references teaches or suggests at least the claimed storage medium of claim 1.

The Examiner asserts: "The *Li* reference teaches ... storing by the Internet service provider, said connection setup information in a storage medium (*Li*: col. 9, lines 50-56)" (Office Action at p. 3). *Li*, however, does not teach that the storage medium has connection setup information "stor[ed] by the Internet service provider" and "transferr[ed] from the Internet service provider to the client" as recited by claim 1. Instead, *Li* discloses a "configuration file" that may be located on "a configuration server ... in a location that is accessible by a customer" (*Li* col. 10, lines 6-17). Neither the configuration server nor the file corresponds to the claimed storage medium. Although the configuration server may include a storage medium, *Li* does not disclose that the Internet service provider transfers the server or the storage medium to the customer. The configuration file is not a storage medium, but instead is simply data that can be stored on a storage medium. Thus, *Li* does not teach or suggest the claimed storage medium.

Short fails to cure the deficiencies of *Li*. *Short* discloses a “nomadic router” that can “run completely in software without any special hardware” (*Short* col. 9, lines 36-37), and which is “able to learn about the network environment it is currently attached using several different methods” (*Short* col. 12, lines 42-44). Even assuming a software embodiment of the router could correspond to the claimed storage medium, *Short* does not disclose that the “nomadic router” includes “connection setup information” stored by, transferred, or otherwise derived from an Internet service provider. Indeed, *Short* avoids the necessity of configuring internet devices altogether. Thus, *Short* does not teach or suggest the claimed storage medium.

Although of different scope, independent claims 4, 5, and 9 recite subject matter similar to claim 1. Claims 2, 3, and 8 depend from claim 1, and claims 6 and 7 depend from claim 5. As already discussed, none of the cited references teach or suggest the claimed storage medium.

Because the cited references fail to teach or suggest each and every claim element recited by claims 1-9, no prima facie case of obviousness has been established. Applicants therefore request the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

In view of the foregoing remarks, Applicants respectfully request reconsideration of the application and withdrawal of the rejections. Pending claims 1-17 are in condition for allowance, and Applicants request a favorable action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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